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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/553,877	04/20/2000	Gerald Peters	91164-9004	6196

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EXAMINER

BLECK, CAROLYN M

ART UNIT

PAPER NUMBER

3626

DATE MAILED: 11/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/553,877

Applicant(s)

PETERS ET AL. *h*

Examiner

Carolyn M Bleck

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 April 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 April 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3. 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Notice to Applicant***

1. This communication is in response to the application filed 20 April 2000. Claims 1-20 are pending. An IDS statement filed 24 July 2000 has been entered and considered. Acknowledgement is made for a claim of domestic priority under 35 U.S.C. 120 to application 08/673,647 (a continuation in part) and application 08/285,501 (a continuation).

### ***Specification***

2. The disclosure is objected to because of the following informalities:

At page 9 lines 19-21 and page 15 lines 3 and 14, there are references to a "Fig. 2", which does not appear in the drawings (i.e., Figs. 2a-2c are in the drawings but not Fig. 2).

Appropriate correction is requested.

***Drawings***

3. The drawings are objected to because they fail to show Fig. 2 as described in the specification. Any structural detail that is of sufficient importance to be described should be shown in the drawing. MPEP § 608.02(d). Correction is required.
4. The drawings are objected to because Figures 1 and 2A are illegible. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
5. Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect may be deferred until after the examiner has considered the proposed drawing correction. Failure to timely submit the proposed drawing correction will result in the abandonment of the application.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 10, 11-14, and 16-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(A) Claims 10, 11-14, and 16-20 recite both a system and method. The Examiner respectfully submits that this claim language is ambiguous. *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990). Appropriate correction is requested.

(B) Claims 12-15 and 18-19 incorporate the deficiencies of claims 11 and 16-17 through dependency, and are therefore, rejected as well.

***Claim Rejections - 35 USC § 101***

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 10, 11-14, and 16-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Under the statute, the claimed invention must fall into one of the four recognized statutory classes on invention, namely, a process (or method); a machine (or system); an article of manufacture; or a composition of matter.

(A) Claims 10, 11-14, and 16-20 appear to be directed toward both a system and a method. However, it is unclear as to which recognized statutory class of invention the system and method of claims 10-11, 16-17, and 20 are directed. In particular, based on the claims are directed to neither a "process" (method) nor a "machine" (system) but rather embrace or overlap two different statutory classes of invention set forth in 35

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U.S.C. 101. 35 U.S.C. 101 is drafted so as to set forth the statutory classes of invention in the alternative only. See MPEP 2173.05(p).

In light of the above, it is respectfully submitted that the claimed invention, fails to satisfy the requirements of 35 U.S.C. 101.

(B) Claims 12-15 and 18-19 incorporate the deficiencies of claims 11 and 16-17 through dependency, and are therefore, rejected as well.

**NOTE:** For purposes of applying art, the Examiner interprets the claims as best as possible in light of the 101 and 112 issues. For purposed of applying prior art, the preamble of:

- (a) Claims 10-15 is assumed to recite a method; and
- (b) Claims 16-20 is assumed to recite a system.

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dworkin (4,992,940) in view of Bosco et al. (5,191,522).

(A) As per claim 1, Dworkin discloses a system and method for automated selection of equipment for purchase through input of user desired specifications, comprising:

(a) a network of terminals connected to a central computer (col. 4, lines 3-12 and figure 1 of Dworkin);

(b) a database connected to the computer (Dworkin; col. 1, lines 63-68 and fig. 1);

(c) a terminal for manually entering in data (col. 4, lines 3-12; col. 2, lines 6-18; and figure 1 of Dworkin);

(d) means for receiving and verifying entered data (Dworkin; col. 2, lines 6-18);

(e) means for updating entered and received data (Dworkin; col. 10, lines 46-53);

(f) a database for storing data (Dworkin; col. 1, lines 63-68 and fig. 1);

(g) means for displaying to the user a product set (reads on "data") (col. 10 line 65 to col. 11 line 16);

(h) menu-driven means for defining a product in response to template (i.e., menu) selections made by a user (Dworkin; col. 5, lines 43-68 and figure 5); and

(i) menu-driven means for obtaining vendor information, for obtaining product specifications, or for accepting and processing an order for a desired item a database connected to the computer for storing data (Dworkin; col. 7, line 7 to col. 8, line 37).

Dworkin is deficient in that his invention does not disclose a means for performing a plurality of insurance functions, such as cashiering, disbursements, document processing, and billing. However, this is only because Dworkin's exemplary embodiment is drawn to a different field, namely the field of computer hardware products (col. 5, lines 16-27). However, Dworkin does suggest the use of his methods to other products or services (col. 5, lines 28-34 and col. 10, lines 22-35).

Moreover, integrated computer network systems that specifically handle insurance matters are well known in the art, as evidenced by Bosco. In particular, Bosco's integrated group insurance information processing and reporting system operates on enterprise-wide network of stored program-controlled application workstation sub-systems and a relational database, wherein each application workstation (i.e., manual entry means) concerns one of the following general functions: insurance sales, insurance underwriting, insurance administration, or actuarial (abstract; figs. 1-9 & 12-13; col. 3, lines 25-45; and col. 22, line 40 to col. 23, line 3 of Bosco). Clearly, Bosco's system encompasses the insurance functions of cashiering, disbursements, document processing, and billing (Bosco; fig. 12). Moreover, Bosco teaches his integrated workstation to offer menu selections commensurate with the function to be performed by the operator (col. 22, lines 13-39). These menus are utilized in order to write and store necessary information, such as the insurance products and terms outlined in columns 4-19 of Bosco, into the relational database. Thus, Bosco teaches a menu-driven insurance product defining means. In addition, Bosco inherently receives an application for insurance products defined within his system, as supported by the fact that he discloses a means for flexible on-line access to contract, form, and general information that is captured by efficient forms filling, recording, and cloning processes (col. 26, lines 55-62).

One having ordinary skill in the art at the time of the invention would have found it obvious to apply the insurance sales and administration techniques disclosed by Bosco within Dworkin's product searching, matching, and presentation system with the motivation of providing users the power or control to access the information regarding the insurance products offered by various vendors in different formats or styles, so that the user may obtain the products most suited to his or her needs.

Dworkin and Bosco fail to expressly disclose a means for pre-defining certain types of data for either immediate or subsequent processing. However, it would have been obvious to the skilled artisan to provide such a feature in the system disclosed collectively by Dworkin and Bosco with the motivation of serving users efficiently so that a user will not be required to wait unnecessarily for a long period of time to obtain information that is easily accessible to the system but is retarded in its transmission due to the retrieval or downloading of data that is more time-consuming to access.

As per the recitation of a file server, Dworkin's teaching of many terminals connected to a central computer and database whereby the central computer can accommodate a large number of users (Dworkin; col. 4, lines 4-12) is functionally equivalent to the claimed file server.

(B) As per claim 2, Dworkin's "templates" are analogous to questionnaires (Dworkin; col. 5, lines 43-68 and figure 5). Further, Dworkin's system reacts globally to the information entered by the user into these templates (Dworkin; col. 5, line 55 to col. 6, line 68).

(C) As per claims 3-7, Bosco's enterprise-wide data base is divided into four basic functions or levels: sales, underwriting, administration, and actuarial and includes data relating to producers, clients, cases, products, competitors, and claims (Bosco; figs. 12-13). Thus, the information contained in Bosco's enterprise-wide data base encompasses the limitations claimed in claims 3-7 (Bosco; columns 4-19). Moreover, one of Bosco's objectives within his invention is to modify and integrate insurance product and insurance administration information quickly and efficiently (col. 1, lines 42-

54 and col. 2, lines 5-25 of Bosco). The motivation for incorporating Bosco's teachings within Dworkin's system is as discussed above in the rejection of claim 1.

(D) Claim 8 differs from system claim 1 by reciting "generating a series of displayed questions to the user for defining at least minimum characteristics of a product and form letters to be used for particular occasions, for each product to be defined" and "receiving corresponding answers to the questions into the computer network and using the answers to define the products."

As per these elements, Dworkin teaches:

(a) displaying, to a user, a set of technical specifications relating to the equipment chosen by the user (col. 11 lines 3-5);

(b) receiving, from the user, a choice of at least one specification relating to the chosen equipment (col. 11 lines 6-8);

(c) searching for a database to locate all items of equipment belonging to the type of equipment belonging to the type of equipment chosen by the user and having the chosen specifications, wherein the set of items retrieved being called a product set (col. 11 lines 9-13); and

(d) displaying the product set to the user (col. 11 line 14).

The remainder of method claim 8 repeats the same limitations of system claim 1, and is therefore rejected for the same reasons given above for claim 1, and incorporated herein. The motivation for incorporating Bosco's teachings within Dworkin's method is as discussed above in the rejection of claim 1.

(E) Claim 9 differs from system claim 1 by reciting "a means for providing a retrievable audit history of every function processed by the system, wherein the audit history is at

least retrievable by date, time, and transaction type," "a means for defining a hierarchy of sales agents comprising who each sales agent reports to and who reports to each sales agent, wherein the means selectively defining thereby a corresponding hierarchy for each product," "a means for real time calculation of commissions for sales agents based on where an agent is in the hierarchy," "a means for the real time reversal of any transaction," "a means for changing a sales agent's commission when a relevant transaction is reversed," "a means for calculating commission tax information," and "a means for printing a commission tax form."

As per these elements, Bosco discloses having a detailed audit trail of transactions within his system (Bosco; col. 25, lines 30-32). The teaching of Bosco directed to the processing of agent-related information was discussed above in the rejection claim 13, and is incorporated herein. It would have been obvious to the skilled artisan to retrieve audit information stored in the system taught collectively by Dworkin and Bosco collectively by person performing the function with the motivation of giving the person who initiated a transaction the opportunity to follow up and complete the same transaction, as he or she would be the most knowledgeable of the transaction and would have developed a rapport with the client in the time spent working on that transaction.

Bosco suggests that representatives (e.g., agents) are assigned to cases based on their rank or experience levels (col. 14, lines 24-33 of Bosco). Bosco also teaches the processing of agent commission schedules within his system (col. 13, lines 2-30). It would have been readily apparent to the artisan that an agent's rank or experience level is directly linked to his or her commission. The motivation for incorporating Bosco's teachings within Dworkin's system is as discussed above in the rejection of claim 1.

Bosco discloses a "commission processing means for calculating commissions due on each account, taxes, minimum payments and issuing advances on earned commissions, means for storing and providing premium and claim information for accounting and tax purposes, means for communicating with the central processing unit and memory, ..." (emphasis added)(Bosco; col. 30, lines 51-59). It would have been obvious to print this information on a tax form with the motivation of providing a hard copy of such information to each agent. The motivation for incorporating Bosco's teachings within Dworkin's system is as discussed above in the rejection of claim 1.

The remainder of system claim 9 repeats the same limitations of system claim 1, and is therefore rejected for the same reasons given above for claim 1, and incorporated herein.

(F) Claim 16 differs from claim 1 by reciting " a means for continuously monitoring user inputs" and "a means for comparing the user input against existing data entries." As per these elements, Dworkin teaches a system programmed to accept inputs from the user fro any or all of the set of product specifications via a number entered on a keyboard (col. 5 lines 55-68) and upon entering the specifications, searching a database for products fulfilling the indicated criteria (col. 6 lines 10-15). The remainder of system claim 16 repeats the same limitations of system claim 1, and is therefore rejected for the same reasons given above for claim 1, and incorporated herein. The motivation for incorporating Bosco's teachings within Dworkin's system is as discussed above in the rejection of claim 1.

(G) Claims 17-19 repeat the same limitations as claims 1-7, and are therefore rejected for the same reasons given above for claims 1-7. The teachings of Dworkin and Bosco

relevant to the features of claims 17-19 are as discussed in the rejections of claims 1-7, above, and incorporated herein.

(H) Claim 20 differs from claims 1, 9, and 16 by reciting “distributed....” As per this element, Dworkin discloses a system including a computer connected to a database, wherein the database can be stored at some remote location, wherein the computer communicates with many terminals, and wherein the terminals can be at the same location as the computer, or located remotely (reads on “distributed”) (Fig. 1 and col. 3 line 60 to col. 4 line 12). The remainder of claim 20 appear to be a compilation of the features of claims 1 and the features of claims 9 and 16, and is therefore rejected for the same reasons given for claims 1, 9, and 16, in combination. The teachings of Dworkin and Bosco relevant to the features of claim 20 are as discussed in the rejections of claims 1, 9, and 16, above, and incorporated herein.

(I) Method claim 10 is similar in scope to system claims 1 and 16, and is therefore rejected under the same rationale given above for claims 1 and 16. The teachings of Dworkin and Bosco relevant to the features of claims 1 and 16 are as discussed in the rejections of claims 1 and 16 above, and are incorporated herein.

(J) Method claim 11 is similar in scope to system claims 1, 10, and 16, and is therefore rejected under the same rationale given above for claims 1, 10, and 16. The teachings of Dworkin and Bosco relevant to the features of claims 1, 10, and 16 are as discussed in the rejections of claims 1, 10, and 16 above, and are incorporated herein.

(K) Claims 12-15 repeat the same limitations as claim 1, and are therefore rejected for the same reasons given above for claim 1. The teachings of Dworkin and Bosco relevant to the features of claims 12-15 are as discussed in the rejections of claim 1, above, and incorporated herein.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to the Applicant's disclosure. The cited but not applied prior art teaches a computerized insurance claim processing system linking the physician's office and the provider of insurance coverage by means of a central administration computer (4,916,611), a method and apparatus for evaluating the insurability of a potentially insurable risk having databases for storing information, and the ability to correlate selected elements of information in respective databases (4,975,840), a computerized system and method for managing work in process for insurance claim processing (5,182,705), a fully integrated and comprehensive health care system including an integrated interconnection and interaction of the patient, health care provider, bank, and insurance company (5,301,105), an auto repair estimate, text, and graphic system (5,432,904), and a computer implemented graphical user interface for receiving instructions and information relating to insurance products, and for displaying insurance proposals (5,523,942).

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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Bleck whose telephone number is (703) 305-3981. The examiner can normally be reached on Monday-Friday, 8:30am – 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached at (703) 305-9588.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 306-1113.

14. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**Or faxed to:**

(703) 305-7687	[Official communications; including After Final communications labeled "Box AF"]
(703) 746-8374	[Informal/ Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th Floor (Receptionist).

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*CB*  
CB

October 22, 2002

*Joseph Thomas*  
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